DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/045,632 (10/045,632) filed on 04/21/09.

Status of Claims

Claims 24, 25 and 28 are currently amended. Claims 2-8, 11-12, 14-19, 22, 26-27 and 29-32 were previously presented. Claims 33 and 34 are new. Claims 1, 9-10, 13, 20-21, 23 are canceled. Thus, claims 2-8, 11-12, 14-19, 22 and 24-34 are currently pending.

Allowable Subject Matter

Claims 2-8, 11-12, 14-19, 22 and 24-34 are allowed subject to the examiner's amendment described below.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Stephen F. Jewett, Reg. No. 27,565 on Tuesday, June 23, 2009.

EXAMINER'S AMENDMENT

The application has been amended as follows: Please amend claims 24, 25 and 28 and add new claims 33 and 34.

24. (Currently Amended) A method for transferring a credit amount from a payor to a payee using a negotiable instrument, the payor sending the credit amount to the ~~payor~~ payee through an online computer system comprising a payment enabler and a wide-area network, a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler having a computer processor receiving pay-out instructions, the pay-out instructions include a payee, a delivery location for the payee, and the credit amount, the credit amount having a first value;

the payment enabler receiving, from the payor computer, a first choice for a first handler, the first handler comprising one of a debit card handler, a bank funds transfer handler, and a credit card handler;

the first handler receiving the credit amount having the first value from the payor, the first handler receiving the credit amount having the first value as one of a group comprising a debit card transfer, a bank funds transfer, or a credit card transfer;

the payment enabler receiving the credit amount having the first value from the first handler;

the payment enabler converting the credit amount from the first value to a second value, wherein the first value and the second value are different forms of monetary value;

the payment enabler receiving a second choice of a second handler from the payee computer;

the payment enabler sending the pay-out instructions to the second handler;

the second handler receiving the credit amount having the second-value from the payment enabler;

the second handler creating a negotiable instrument according to the pay-out instructions, the negotiable instrument paid with the credit amount of the second value; and

the second handler providing the negotiable instrument to the payee, wherein the negotiable instrument is provided to the payee by sending the negotiable instrument to the payee's delivery location.

25. (Currently Amended) A method for transferring a credit amount from a payor to a payee using a payment instrument, the payor sending the credit amount to the ~~payor~~ payee through an online computer system comprising a payment enabler and a wide-area network, a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler having a computer processor receiving pay-out instructions, the pay-out instructions include a payee, an address of the payee, and the credit amount, the credit amount having a first value;

the payment enabler determining a first handler;

the first handler receiving the credit amount having the first value from the payor, the first handler receiving the credit amount having the first value as one of a group comprising a debit card transfer, a bank funds transfer, or a credit card transfer;

the payment enabler receiving the credit amount having the first value from the first handler;

the payment enabler converting the credit amount from the first value to a second value, wherein the first value and the second value are different forms of monetary value;

the payment enabler creating a first stored value fund;

the payment enabler storing the credit amount having the first value in the first stored value fund;

the payment enabler determining a second handler to prepare a payment instrument;

the payment enabler sending the pay-out instructions to the second handler;

the second handler receiving the credit amount having the second value from the payment enabler;

the second handler creating the payment instrument according to the pay-out instructions, the payment instrument paid with the credit amount; and

the second handler providing the payment instrument to the payee, wherein the payment instrument is provided to the payee by sending the payment instrument to the payee's ~~residence~~ address.

28. (Currently Amended) A method for transferring a credit amount from a payor to a payee using a payment instrument, the payor sending the credit amount to the ~~payor~~ payee through an online computer system comprising a payment enabler and a wide-area network, a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler having a computer processor receiving pay-out instructions, the pay-out instructions include a payee, a residence address of the payee, and the credit amount, the credit amount having a first value;

the payment enabler determining a first handler;

the first handler receiving the credit amount having the first value from the payor, the first handler receiving the credit amount having the first value as one of a group comprising [[of]] a debit card transfer, a bank funds transfer, or a credit card transfer;

the payment enabler receiving the credit amount having the first value from the first handler;

the payment enabler storing the credit amount having the first value in a first stored value fund, the first stored value fund associated with the payor;

the payment enabler converting the credit amount from the first value to a second value, wherein the first value and the second value are different forms of monetary value;

the payment enabler storing the credit amount having the second value in a second stored value fund, the second stored value fund associated with the payee;

the payment enabler receiving a choice of a second handler from the payee computer, the second handler one of a debit card handler, a bank funds transfer handler, a credit card handler, a promotion handler, or a money order handler;

the payment enabler sending the pay-out instructions to the second handler;

the payment enabler sending the credit amount having the second value from the second stored value account to the second handler;

the second handler creating the payment instrument according to the pay-out instructions, the payment instrument paid with the credit amount of the second value; and

the second handler providing the payment instrument to the payee, wherein the payment instrument is provided to the payee by sending the payment instrument to the payee's residence address.

33. (New) The method for transferring the credit amount out of the online system using the negotiable instrument as recited in claim 24, wherein the form of monetary value of one of the first value and the second value is a currency of one country, and wherein the form of monetary value of the other of the first value and the second value is a currency of a different country.

34. (New) The method for transferring the credit amount out of the online system using the negotiable instrument as recited in claim 24, wherein the form of monetary value of one of the first value and the second value is promotional points, and wherein the form of monetary value of the other of the first value and the second value is currency.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The closest prior art of record is Doggett, US Pat. No. 5,677,955; Farris, US Pub. No. 2002/0082962; and Hoter-ishay, US Pub. No. 2003/0088512.

Doggett teaches an electronic instrument created in a computer-based method for effecting a transfer of funds from an account of a payer in a fund-holding institution to a payee. The electronic instrument includes an electronic signature of the payer, digital representations of payment instructions, the identity of the payer, the identity of the payee, and the identity of the funds-holding institution.

As stated in applicant's remarks (06/07/07), the claimed invention is distinct from Doggett because:

> In stark contrast to claim 10, Doggett does not disclose any method for maintaining an internally managed temporary stored value fund. Rather, Doggett discloses a method for "effecting a transfer of funds from an account of a payer in a funds-holding institution to a payee..." Doggett at p. 18, col. 3, 11.4-6. This method interfaces with a third party database, for "interbank clearing of checks," such as the Automated Clearing House. Id__:. at p. 19, col. 6, l1.6-7.
>
> As understood by the Applicants, the Office Action takes the position that the Automated Clearing House functions as a temporary stored value fund, an intermediary between the funds being credited to the payee, and debited to the payor. As stated in Doggett, the Federal Reserve's Automated Clearing House "receiv[es] a transaction over the network and then split[s] and rout[es] the debit and credit portions of the transaction to the payer's and payee's banks." Id___~. at p. 17, col. 2, 11. 20-26. With all due respect, Claim 10 recites a stored value account that is configured in an entirely different fashion. Here, a stored value fund is maintained internally by the online system and remains in place as long as the payee or payor has credit remaining within the stored value account on the online system. After money is paid-in by a payor, the "[m]oney is a credit amount stored as a database entry corresponding to the user." Application at p.3, 11 1-9. "This database entry corresponds to the stored value fund for that user..." Id____~. at p.3, 11.9-11. While in Doggett, the clearing house is run by a third party to route data and never has money stored within it, in contrast, a fund is maintained internal to the online system to store value in the claimed invention.
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> (See Applicant's Remarks, 06/07/07, pg. 10)

Farris teaches a method and system of transferring monetary value for unbanked customers, by depositing cash, or the like, into a kiosk terminal. A security code is provided to the customer depositing the cash or the like. The method and system may accept any form of payment including cash, coins, bank draft, credit card, debit card, stored value card and any other form of cash value. The value may be converted or transferred to other instruments of monetary value (e.g., currency, legal tender or government obligation etc.). The security code is forwarded by the customer in any manner to a destination where the security code is input by a patron into a kiosk terminal. The monetary value, less a transaction fee, is dispensed to the patron at the destination kiosk terminal.

As stated in applicant's remarks (04/21/09), Farris may not serve as a prior art reference because:

> As to the '384 Application, Applicants apologize for not specifically citing (on page 12 of the prior Response) the specific reference to the '384 Application where the "payment enabler converting" feature can be found. However, the unintentional omission of a specific reference was not intended to be an "admission" that the feature was not disclosed. In fact, such feature can be found at pages 9, 10, 39, 43, 48 and 49 (referring to the handling or service fees giving rise to different values received by and paid to the payor and payee using the intermediary's payment enabler 240). The Examiner will note that service fees are also described in conjunction with the payment conversion function 328 in the present Application (e.g., page 7 of the Specification).
>
> Since this feature is disclosed in the '384 Application (and was the only feature identified by the Examiner as not supported by the '384 Application), the '384 Application does fully support the present Application having a priority date based on the filing date of the '384 Application (December 30, 1999).
>
> In addition, Applicants point out that the '615 Application incorporates by reference the entire disclosure of the '384 Application (see page 7 of the '615 Application), and thus for this reason alone, the '615 Application also fully

> supports the present Application having a priority date based on the filing date of the '615 Application (July 11, 2000).
>
> Furthermore, the Applicants respectfully submit the feature of "the payment enabler receiving payout instructions" can be found in the '615 Application. While unnecessary to specifically find a description in the '615 Application since such feature is in the fully incorporated '384 Application, Applicants point to, among other places, pages 8, 9, 14, 17 and 18 of the '615 Application that refer to the payment enabler being provided transaction details pertaining to the name and an email address identifier of the payee, the amount to be credited (transferred), and sending (to a location of the payee) a paper check.
>
> Accordingly, given that the claims are supported by both the '384 Application and the '615 Application, the present Application is entitled to a priority date of December 30, 1999, and thus Farris is not a proper reference and the claims are allowable thereover.
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> (See Applicant's Remarks, pg. 13)

Hoter-ishay teaches a computer-implemented method including steps of storing a first amount of money from funds of a first party, issuing a unique identifier to the first party, and storing the unique identifier and the first amount. The method further includes the steps of receiving the unique identifier and a request to release a second amount of money from a second party. Hoter-ishay uses AOPRS which are associated with a predetermined amount of money to accomplish its objective.

The instant application is distinct from Hoter-ishay in a few ways. First, unlike Horter-ishay, the claimed invention requires a choice or determination of a first handler. Second, Horter-ishay uses one standard of value, the AOPR, that Is associated with a predetermined amount of money. Thus, Horter-ishay does not address the conversion of the credit amount having the first value from the first handler to a credit amount having a second value for the second handler as in the claimed invention. Third, in Horter-ishay the second party requests a release of the second amount of money

whereas in the claimed invention the negotiable instrument (payment instrument) is created and provided to the payee in accordance with the pay-out instructions received.

Interpretation of "payment enabler"

The term "payment enabler" has not been interpreted as broad enough to include a human operator alone. The preamble of the claimed invention recites, "an online computer system comprising a payment enabler and a wide-area network." The body of the claim refers to "the payment enabler having a computer processor." The interpretation of the payment enabler as a machine or apparatus appears consistent with applicant's specification. (E.g., See the following excerpts from applicant's specification (10/26/01), "The present invention facilitates online money transfers out of an online payment enabler by using a payment instrument such as a money order," pg. 2, line 31+ - col. 3, line 6; "Users 110, 130 and/or agents interact with the payment enabler 170 through user interfaces 180," pg. 3, line 28+ - pg. 4, line 3; "The payment enabler 170 may be implemented on one or more computers in one or more locations where the various computers communicate over a network," pg. 6, liens 20-27.).

Claim 24 is allowed because the closest prior art of record, Doggett, Farris and Hoter-ishay, alone or in combination, fails to teach or suggest the limitations of a method for transferring a credit amount from a payor to a payee using a negotiable instrument, the payor sending the credit amount to the payee through an online computer system comprising a payment enabler and a wide-area network, a payor computer and a payee computer are in communication with the wide-area network, the method comprising:

the payment enabler having a computer processor receiving pay-out instructions, the pay-out instructions include a payee, a delivery location for the payee, and the credit amount, the credit amount having a first value;

the payment enabler receiving, from the payor computer, a first choice for a first handler, the first handler comprising one of a debit card handler, a bank funds transfer handler, and a credit card handler;

the first handler receiving the credit amount having the first value from the payor, the first handler receiving the credit amount having the first value as one of a group comprising a debit card transfer, a bank funds transfer, or a credit card transfer;

the payment enabler receiving the credit amount having the first value from the first handler;

the payment enabler converting the credit amount from the first value to a second value, wherein the first value and the second value are different forms of monetary value;

the payment enabler receiving a second choice of a second handler from the payee computer;

the payment enabler sending the pay-out instructions to the second handler;

the second handler receiving the credit amount having the second-value from the payment enabler;

the second handler creating a negotiable instrument according to the pay-out instructions, the negotiable instrument paid with the credit amount of the second value; and

the second handler providing the negotiable instrument to the payee, wherein the negotiable instrument is provided to the payee by sending the negotiable instrument to the payee's delivery location.

Independent claims 25 and 28 are allowed based on a similar rationale. Dependent claims are allowable for the same reasons as the claims from which they depend.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoter-ishay, US Pub. No. 2003/0088512.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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